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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,836	12/21/2000	Edward O. Clapper	42390P10784	8616
21906	7590	09/20/2004	EXAMINER	
TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			TIEU, BINH KIEN	
			ART UNIT	PAPER NUMBER
			2643	

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,836

Applicant(s)

CLAPPER, EDWARD O.

Examiner

BINH K. TIEU

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28 and 30-42 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 28 and 30-42 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 28 and 30-42 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 34 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Kowalski et al. (U.S. Pat. #: 6,728,355).

Regarding claim 34, Kowalski et al. ("Kowalski") teaches a telephone calling card comprising:

a memory having stored therein a plurality of predetermined messages (i.e., credit card inherently has memory such as magnetic strip to store credit card number, Personal Identification Number (PIN), etc., and the credit card is read by a card reader), one or more of said messages to replace the caller ID value for the telephone call at which the calling card is used (i.e., when the caller makes a call at a pay phone,

the caller's credit card number is provided and replaces the calling telephone number as the Automatic Number Identification (ANI) (see col.1, lines 57-60; col.3, line 54 – col.4, line 4).

Regarding claim 40, Kowalski teaches a telephone calling card comprising:
a memory having stored therein a plurality of predetermined messages (i.e., credit card inherently has memory such as magnetic strip to store credit card number, Personal Identification Number (PIN), etc., and the credit card is read by a card reader), one or more of said messages to be received by a recipient communications device in place of the respective caller ID value for the telephone at which the calling card is used (see col.1, lines 57-67; col.3, line 54 – col.4, line 4).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 28 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tasaki et al. (U.S. Pat. #: 4,879,744 as cited in the previous Office Action) in view of in view of Snyder et al. (U.S. Pat. #: 5,784,444 also cited in the previous Office Action) and Kowalski et al. (U.S. Pat. #: 6,728,355).

Regarding claim 28, Tasaki et al. ("Tasaki") teaches a telephone calling card comprising:

a memory having stored therein a unique identifying value (i.e., calling account number, card data, etc.), said memory having a storage area therein for holding a value specifying a respective telephone number which is to be called upon usage of the calling card, the respective telephone number to be stored in the memory at a time later than the manufacturing of a calling card (col.1, line 48 – col.2, line 16).

It should be noticed that Tasaki fail to clearly teach said memory having stored therein a predetermined message for substitution in place of the respective caller ID

value of a telephone at which the calling card is used. However, Snyder et al.

(“Snyder”) teaches a telecommunications system that allows a caller to make call by using of a calling card. The system further allows the caller to manually input a plurality of predetermined messages such as messages of ICLIDTO number 208, indicia 210 and/or short message 212 as shown in figures 6 and 6A manually input to be transmitted and displayed at called party terminal (col.4, lines 20-67). Snyder does not teach the calling card stored therein caller ID information. However, Kowalski et al. (“Kowalski”) teaches a telecommunications system that allows a caller to make call by using of a credit card. It should be understood that the credit card inherently has memory such as magnetic strip to store credit card number, and the credit card is read by a card reader. When the caller makes a call at a pay phone, the caller’s credit card number is provided and replaces the calling telephone number as the Automatic Number Identification (ANI) (see col.1, lines 57-60). Thus, Kowalski teaches the credit card having magnetic strip storing credit card number read on “said memory having stored therein a predetermined message for substitution in place of the respective caller ID value of a telephone at which the calling card is used ”.

Therefore, it would have been obvious to one of ordinary skilled in the art the time the invention was made to incorporate the use of such memory stored therein a plurality of predetermined messages, as taught by Kowalski, in view of Tasaki and Snyder, in order to establish a calling card communication with the caller identification information.

Regarding claim 30, Snyder further teaches limitations of the claim as shown in pictures 6 and 6A, col.4, lines 47-53 and col.5, lines 16-32.

Regarding claim 31, Tasaki further teaches limitations of the claim in col.1, lines 53-58.

Regarding claim 32, Snyder further teaches limitations of the claim in col.4, lines 57-56.

6. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tasaki et al. (U.S. Pat. #: 4,879,744) in view of Snyder et al. (U.S. Pat. #: 5,784,444) and Kowalski et al. (U.S. Pat. #: 6,728,355) as applied to claim 28 above, and further in view of Taskett (U.S. Pat. #: 5,923,734 also cited in the previous Office Action).

Regarding claim 33, Tasaki, Snyder and Kowalski, in combination, teaches all subject matters as claimed above, except for said plurality of predetermined messages being printed on the card. However, Taskett teaches a prepaid card or phone card having visual indicia on one or both sides of the card. While connected to the service provider network, audio indicia relating to the visual indicia on the prepaid instrument is suitably communicated to the consumer at appropriate times or intervals (see

Abstract, col.5, lines 15-45 and col.6, lines 47-53) for a purpose of improving a distributed system for effecting commercial telephone card transactions by a consumer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of teachings of the prepaid phone card imprinted with a visual indicia associated with corresponding audio indicia as predetermined message or messages printed on the card, as taught by Taskett, into view of Tasaki, Snyder and Kowalski in order to distinguish the message card with other standard calling cards.

7. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kowalski et al. (U.S. Pat. #: 6,728,355) in view of Taskett (U.S. Pat. #: 5,923,734).

Regarding claim 35, Kowalski teaches all subject matters as claimed above, except for said plurality of predetermined messages being printed on the card.

However, Taskett teaches a prepaid card or phone card having visual indicia on one or both sides of the card. While connected to the service provider network, audio indicia relating to the visual indicia on the prepaid instrument is suitably communicated to the consumer at appropriate times or intervals (see Abstract, col.5, lines 15-45 and col.6, lines 47-53) for a purpose of improving a distributed system for effecting commercial telephone card transactions by a consumer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of teachings of the prepaid phone card imprinted with a visual indicia associated with corresponding audio indicia as

predetermined message or messages printed on the card, as taught by Taskett, into view of Kowalski in order to distinguish the message card with other standard calling cards.

8. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kowalski et al. (U.S. Pat. #: 6,728,355) in view of Snyder et al. (U.S. Pat. #: 5,784,444).

Regarding claim 36, Kowalski teaches all subject matters as claimed above, except for the feature of an indicator to enable manual entry of message. However, Snyder further teaches limitations of the claim in col.4, lines 53-56 for a purpose of helping called party to identify the incoming call.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of teachings of the feature of an indicator to enable manual entry of message, as taught by Snyder, into view of Kowalski in order to provide related caller ID information to the called party.

9. Claims 37-39 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kowalski et al. (U.S. Pat. #: 6,728,355) in view of Tasaki et al. (U.S. Pat. #: 4,879,744).

Regarding claim 37, Kowalski further teaches the well-known billing formats of credit card and the calling card (i.e., billing or account information). Kowalski, however, fails to clearly teach said calling card comprising said memory has a storage area therein for holding a value specifying an account balance, the account balance

being stored in the memory at a time later than the manufacturing the calling card. Tasaki teaches such features in col.1, lines 53-58, col.3, lines 39-46 and col.4, lines 26-32, line 2 for a purpose of allowing caller to make calls without carrying coins or cash. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the memory of the calling card having a storage area therein for holding a value specifying a respective telephone number which is to be called upon usage of the calling card, as taught by Tasaki, in view of Kowalski in order to use the telephone card as a substitute for cash payment.

Regarding claims 38 and 41, Tasaki further teaches limitations of the claim in col.1, lines 48-52 and col.1, line 64 – col.2, line 2.

Regarding claims 39 and 42, Tasaki further teaches limitations of the claim in col.1, line 64 – col.2, line 2.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (703) 305-3963 and E-mail address: BINH.TIEU@USPTO.GOV.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

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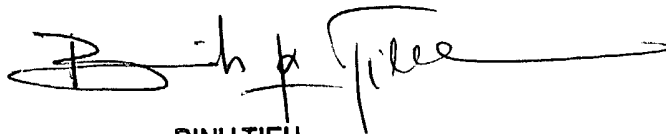
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(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington VA, Sixth Floor (Receptionist, tel. No. 703-
305-4700).

A handwritten signature in black ink, appearing to read "Binh Tieu", with a long horizontal flourish extending to the right.

BINH TIEU
PRIMARY EXAMINER

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Date: September 08, 2004
